REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.116, and in light of the remarks which follow are respectfully requested.

By the present amendments, the features of claims 7 and 9 have been added to claim 1, and these claims canceled. Due to the cancellation of claim 9, the dependencies of claims 10 and 26 have been changed. Claims 1-6, 8, 10 and 12-31 remain pending in this application with claims 16, 18 and 31 withdrawn from consideration.

Claims 4-7 were rejected under 35 U.S.C. §112, second paragraph, for the reason given in the third paragraph on page 2 of the Office Action. Reconsideration of this rejection is requested in view of the above amendments and the following reasons.

Claim 1 has been currently amended to specify that the polycarbonate prepolymer component comprises a polycarbonate polyol. It should be clear from page 7 of the specification and the discussion in the Remarks section of the last Response that the adhesive of the present invention includes a polycarbonate prepolymer having a polycarbonate polyol radical as well as a prepolymer based on a non-polycarbonate polyol. There is now literal antecedent basis in claim 1 for the terminology in claims 4-7.

Accordingly, the §112 rejection of claims 4-7 should be withdrawn. Such action is respectfully requested.

Claims 1-6, 8-10, 12-15, 17, 19-21, 23-25 and 27-29 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 4,107,386 to Gruber et al. for the reasons provided on page 2 of the Office Action. Reconsideration and withdrawal of these rejections are requested in view of the aforementioned amendments and for at least the following reasons.

Gruber et al. '386 does not disclose adhesives containing polycarbonate polyols which have isocyanate or silane end groups. To the contrary, the polycarbonate polyol radicals described in the reference have end groups derived from (meth)acrylic acids. Clearly, the adhesives of the reference do not anticipate the presently claimed adhesives.

Moreover, there is nothing in the disclosure of Gruber et al. '386 which would motivate those of ordinary skill to replace the meth(acrylate) end groups with silane or isocyanate groups. Thus, the claimed adhesives are unobvious over the disclosure of the reference.

For at least the above reasons, the §102(b) and §103(a) rejections over Gruber et al. '386 should be withdrawn. Such action is earnestly solicited.

Claims 1-10, 12-15, 17, 19-25 and 27-29 stand finally rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over JP 02-003489 for reasons provided on page 3 of the Office Action. Reconsideration of these rejections is requested in view of the above amendments and for at least the reasons which follow.

The Japanese Publication Abstract discloses an adhesive comprising (A) a prepolymer containing isocyanate groups and (B) a polyfunctional compound. The composition may contain $CaCO_3$, talc and/or TiO_2.

Claim 1, as currently amended, specifies that at least 3% by weight of the filler is composed of at least one conductive filler. Canceled claim 7 recites the presence of a conductive filler. None of the fillers disclosed in this reference is conductive. Accordingly, the adhesives disclosed in JP '489 do not anticipate the presently claimed adhesives.

Moreover, there is no disclosure or suggestion in the reference which would motivate those of ordinary skill to substitute a conductive filler for the fillers which may optionally be present in the adhesives of the reference. Thus, the presently claimed adhesives are not obvious from the adhesives described in the reference.

For at least the above reasons, the §102(b) and §103(a) rejections over JP '489 should be reconsidered and withdrawn. Such action is respectfully requested.

Entry of the present amendments is requested because entry thereof would clearly place this application in allowable condition. No new issues have been raised since the features of using a conductive filler and a polycarbonate polyol radical having isocyanate or silane end groups were already recited in dependent claims.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

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